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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,719	01/03/2002	Thomas E. Creamer	BOC9-2000-0061 (196)	8949
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AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER SWEARINGEN, JEFFREY R	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/038,719

Applicant(s)

CREAMER ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-18, 20-25, 28-30 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-18, 20-25, 28-30 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/4/2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 1/4/2006 have been fully considered but they are not persuasive.

3. Applicant alleged that Wu failed to disclose inserting in an instant message a voice conference identifier comprising a voice conference call list identifying conference call nodes. In paragraph 0070, the START TALK button in the instant message was used to identify if a call could be made with the recipient. The ability for one call to be made to one recipient in an instant message fulfilled Applicant's claim language of a voice conference call list identifying conference call nodes. The conference call node identifier in paragraph 0070 was the recipient node and whether the START TALK button was enabled.

4. The presence of the START TALK button in the instant message was computer program code embedded in an instant message. The START TALK button was embedded program code that, when executed at a recipient node, established a voice communications link between an instant message sender and a recipient at the recipient node.

5. The references was considered "in its overall context", contrary to Applicant's allegations.

6. Applicant failed to further address any of the remaining references applied in the application.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 5-6, 9-10, 12, 14, 17-18, 20, 24-25, 28-29, 33, and 36-37 are rejected under 35

U.S.C. 102(e) as being anticipated by Wu et al. (U.S. Pub. No. 2002/0023131).

9. In regard to claim 1, Wu discloses *inserting in an instant message (IM) a voice conference identifier comprising a voice conference call list identifying conference call nodes; embedding computer program code in said IM, wherein execution of said computer program code at a recipient node establishes a voice communications link between an IM sender and a recipient at the recipient node; transmitting said IM from a sender to a recipient at a recipient node; a recipient client detecting the voice conference identifier within the IM; responsive to the detecting step, an IM interface of the recipient displaying a user-selectable text or graphic symbol; and responsive to a user-selection of said displayed text or graphic symbol, automatically establishing a voice communication link between the recipient and the sender.* See Wu, paragraphs 0066-0074, where a user can send a request to initiate a peer-to-peer audio session over instant messenger and a recipient can allow the conversation by selecting a "START TALK" UI button and thereafter establishing said session. The selection of a graphic symbol is the START TALK UI button described in paragraphs 0069-0075. The establishment of the voice communications link upon selecting the graphical symbol via embedded computer program code is in paragraphs 0071-0074.

10. In regard to claim 5, Wu is applied as in claim 1. Wu further discloses *said voice conference call list specifies IP addresses for said identified conference call nodes.* The IP address is indicated in paragraph 0071.

11. In regard to claim 6, Wu is applied as in claim 1. Wu further discloses *inserting in said IM/chat message a selectable symbol for initiating said voice communication link with said selected ones of said identified conference call nodes.* See the START TALK UI with a START TALK button in paragraphs 0069-0075 of Wu.

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12. Claim 9 has substantially the same limitations as claim 1. Therefore, the rejection of claim 1 is equally applicable against claim 9.

13. In regard to claim 10, Wu is applied as in claim 9. Wu further discloses *said displaying step displays a single icon and said establishing step establishes said voice conference call between said selected ones of said identified conference call nodes responsive to said selection of said single icon.*

See Wu, paragraph 0074.

14. In regard to claim 12, Wu is applied as in claim 9. Wu further discloses *extracting from said IM embedded software program.* The establishment of the voice communications link upon selecting the graphical symbol via embedded computer program code is in paragraphs 0071-0074.

15. Claim 14 has substantially the same limitations as claim 5. Therefore, the rejection of claim 5 is equally applicable against claim 14.

16. In regard to claim 17, Wu is applied as in claim 9. Wu further discloses *responsive to said selection of said at least one icon, determining a telephone number or an IP address for said selected ones of said identified conference call nodes based on said voice conference call list.* Wu establishes the talk session based on selection of an icon in paragraph 0074. The icon identifies appropriate IP addresses as shown in paragraph 0071.

17. Claim 18 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 18.

18. Claim 20 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 20.

19. Claim 24 has substantially the same limitations as claim 5. Therefore the rejection of claim 5 is equally applicable against claim 24.

20. Claim 25 has substantially the same limitations as claim 6. Therefore the rejection of claim 6 is equally applicable against claim 25.

21. Claim 28 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 28.

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22. Claim 29 has substantially the same limitations as claim 6. Therefore the rejection of claim 6 is equally applicable against claim 29.

23. Claim 33 has substantially the same limitations as claim 5. Therefore the rejection of claim 5 is equally applicable against claim 33.

24. In regard to claim 36, Wu is applied as in claim 28. Wu further discloses *responsive to said selection of said at least one icon, determining a telephone number or an IP address for said selected ones of said identified conference call nodes based on said voice conference call list*. Wu establishes the talk session based on selection of an icon in paragraph 0074. The icon identifies appropriate IP addresses as shown in paragraph 0071.

25. Claim 37 has substantially the same limitations as claim 1. Therefore the rejection of claim 1 is equally applicable against claim 37.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 3-4, 13, 16, 22-23, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Hanson et al. (U.S. Patent No. 6,697,474).

28. In regard to claims 3, 16, 22, and 35, Wu is applied as in claims 1, 9, 20, and 28. Wu fails to disclose the establishment of a voice communications link over a PSTN network. However, Hanson in the same field of endeavor discloses establishing a telephone call via an instant message by utilizing the public switched telephone network. See Hanson, figure 1, column 3, lines 23-24, column 9, lines 11-42. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Wu invention with the teachings of Hanson for the purpose of decreasing costs for a user (Hanson, column 1, lines 39-47). Wu gives motivation by stating that service providers are attempting to provide additional

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services to instant messaging users (paragraph 0003-0004) and stating that the talk tool in Wu is similar to a telephonic session (paragraph 0084) and may support additional functionality (paragraph 0082).

29. In regard to claims 4, 13, 23, and 32, Wu is applied as in claims 1, 9, 20, and 28. Wu fails to disclose establishing the link between a user and their telephone number for making a voice call.

However, Hanson in the same field of endeavor discloses this feature in Figure 4A. The motivation for the combination of Wu and Hanson has been previously stated.

30. Claims 2, 15, 21, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Bogard (U.S. Patent No. 6,757,365).

31. In regard to claim 2, Wu is applied as in claim 1. Wu fails to disclose the use of VOIP for initiating a voice communication link. However, Bogard in the same field of endeavor discloses the use of voice over Internet Protocol to initiate a voice communication link. See Bogard, column 5, lines 42-54. It would have been obvious to one of ordinary skill in the art to modify the Wu invention with the teachings of Bogard in order to allow an alternate method of voice communications. Motivation exists to combine Wu and Bogard in the fact that Wu is a version of the instant messenger program created by America Online and Bogard is designed to assist and modify instant messenger programs such as AOL Instant Messenger (Bogard, column 1, lines 13-24) which is taught by Wu (paragraphs 0003-0004).

32. Claims 15, 21, and 34 have substantially the same claim limitations as claim 2 and the rejection of claim 2 is equally applicable against all claims herein mentioned.

33. Claims 7, 11, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu.

34. In regard to claim 7, Wu is applied as in claim 1. In the rejection of claim 6, it has been shown that Wu has the ability to implement a single icon to assist in launching a voice communications link through an instant message. It would be obvious to one of ordinary skill in the art that if a single icon to perform said functionality can be implemented in the Wu invention, that a plurality of icons could likewise be implemented in the Wu invention.

35. Claims 11, 26, and 30 have substantially the same claim limitations as claim 7. Therefore the rejection against claim 7 is equally applicable against all claims herein mentioned.

### ***Conclusion***

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

37. Rodenstein, Roy et al. "Talking in Circles: Designing a Spatially-Grounded Audioconferencing Environment." Proceedings of the SIGCHI Conference on Human Factors in Computing Systems. The Hague, the Netherlands, 2000. ACM Press. pp. 81-88.

38. Nardi, Bonnie et al. "Interaction and Outeraction : Instant Messaging in Action." Proceedings of the 2000 ACM Conference on Computer Supported Cooperative Work. Philadelphia, PA, 2000. ACM Press. pp. 79-88.

39. Milewski, Allen et al. "Providing Presence Cues to Telephone Users". Proceedings of the 2000 ACM Conference on Computer Supported Cooperative Work. Philadelphia, PA, 2000. ACM Press. pp. 89-96.

40. Jiang, Wenyu et al. "Towards Junking the PBX : Deploying IP Telephony". Proceedings of the 11<sup>th</sup> International Workshop on Network and Operating Systems Support for Digital Audio and Video. Port Jefferson, NY, 2001. pp. 177-185.

41.	DeSimone et al.	U.S. Patent No. 6,212,548 B1
42.	Aravamudan et al.	U.S. Patent No. 6,301,609 B1
43.	Rudy et al.	U.S. Patent No. 6,360,252 B1
44.	Maurille	U.S. Patent No. 6,484,196 B1
45.	Milewski et al.	U.S. Patent No. 6,501,834 B1
46.	Wellner et al.	U.S. Patent No. 6,628,767 B1
47.	Kung et al.	U.S. Patent No. 6,671,262 B1
48.	Stimmel	U.S. Patent No. 6,678,719 B1
49.	Shaffer et al.	U.S. Patent No. 6,694,351 B1
50.	Ogilvie	U.S. Patent No. 6,701,347 B1
51.	Isaacs et al.	U.S. Patent No. 6,760,754 B1
52.	Cloutier	U.S. Patent No. 6,772,188 B1




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jason Cardone  
Supervisory Patent Examiner  
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